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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,391	09/29/2000	Marcia Rojewski	Hartford-3	1818

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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,391

Applicant(s)

ROJEWSKI ET AL.

Examiner

Vanel Frenel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/14/05 has been entered.

Notice to Applicant

2. This communication in response to the RCE filed on 04/14/05. Claims 1-26 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risk & Insurance; Technology: (Unlocking the Neural Network by John Mutch; Jan 1999) in view of High-tech sleuths by Leslie Werstein Hann.(Best Review . Property /Casualty insurance edition; Nov. 1998; Vol.99, Iss.7; pg 83; 3 pgs).

(A) As per claim 1, John discloses a computerized method for identifying select ones of insurance records which possess a favorable subrogation potential (Page 3, Paragraphs 9-12) the method comprising the steps of: employing a computer for: receiving data indicative of a plurality of claims (Page 3, Paragraphs 7-14).

John does not explicitly disclose automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data; automatically identifying risk factors for each of the select claims; and, automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery and outputting the resulting value.

However, these features are known in the art, as evidenced by Leslie. In particular, Leslie suggests automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); automatically identifying risk factors for each of the select claims (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); and, automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); and outputting the resulting value (The Examiner interprets "easily outstrip those in the other lines of business" to be a form of outputting the resulting value (See Leslie, Page 3, Paragraphs 2-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Leslie within the system of John with the motivation of providing insurance fraud-fighters another set of tools to help them track down criminals. Powerful new software systems promise to dramatically improve their results (See Leslie, Page 1, Paragraph 5).

(B) As per claim 2, Leslie discloses the method further comprising automatically providing recovery strategy recommendation and recovery specialist checklists to optimize steps taken to recovery losses at minimum expense (Page 3, Paragraph 2).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(C) As per claim 3, John discloses the method wherein the receiving the data comprises: receiving the data in electronic form (Page 3, Paragraphs 7- 14).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(D) As per claim 4, John discloses the method wherein the receiving the data comprises: providing a user interface (Page 1, Paragraphs 1-3); and, extracting the data from the user interface (Page 1, Paragraphs 1-3).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(E) As per claim 5, Leslie discloses the method wherein the calculating the base score comprises calculating a likelihood a payment will be made by a legally liable party (Page 4, Paragraphs 3-6).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(F) As per claim 6, Leslie discloses the method wherein the calculating a base score further comprises calculating a probable percentage of losses recovered through payments received from said legally liable party (Page 4, Paragraphs 3-6).

(G) As per claim 7, Leslie discloses the method wherein the calculating a base score further comprises: identifying at least one economic factor pertinent to said base score (Page 1, Paragraph 3); and, calculating a first adjustment dependently upon said identified at least one economic factor (Page 2, Paragraphs 4-7).

(H) As per claim 8, Leslie discloses the method wherein the calculating a base score further comprising: identifying at least one collection efficiency or strategy pertinent to said base score (Page 1, Paragraph 3); and, calculating a second adjustment dependently upon said identified at least one collection efficiency or strategy (Page 2, Paragraphs 3-7).

(I) As per claim 9, Leslie discloses the method wherein the calculating a base score further comprising calculating said base score using said calculated likelihood a payment will be made, calculated probable percentage of losses recovered, calculated first adjustment and calculated second adjustment (Page 3, Paragraphs 4-9).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(J) As per claim 10, Leslie discloses the method wherein said risk factors are identified using additional data from at least one external database (Page 2, Paragraphs 4-6).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(K) As per claim 11, Leslie discloses the method wherein said risk factors address recovery expectations due to limitations of legal process arising from state prohibitions (Page 4, Paragraphs 1-6).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(L) As per claim 12, John discloses the method wherein said risk factors address recovery expectations due to state recovery limitations based on a said legally liable party's culpability (Page 4, Paragraphs 1-6).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(M) As per claim 13, John discloses the method wherein said risk factors address if other agencies have attempted and failed to recover on the claim, and said agencies are selected to include attorneys, in-house efforts or outside agents (Page 4, Paragraphs 1-6).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(N) As per claim 14, John discloses the method wherein said risk factors address expected difficulties is locating said legally liable party (Page 4, Paragraphs 1-6).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(O) As per claim 15, John discloses the method wherein said risk factors address issues selected from the group consisting of expectations due to limitations of legal process arising from state prohibitions, recovery expectations due to state recovery limitations based on a said legally liable party's culpability, if other agencies have attempted and failed to recover on the claim, and expected difficulties is locating said legally liable party (Page 4, Paragraphs 1-6).

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(P) As per claim 16, John discloses the method further comprising quantifying said value indicative of an expected subrogation recovery at specific periods of time (Page 4, Paragraphs 1-2).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(Q) As per claim 17, John discloses the method wherein said quantified values factor in expected collection expenses (Page 3, Paragraphs 7-9).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(R) As per claim 18, John discloses the method wherein said quantifying at specific periods of time comprises: calculating a liquidation value for said claim for each specified period of time (Page 3, Paragraphs 7-9); calculating an expected expense value for said claim for each specified period of time (Page 3, Paragraphs 7-9); and, specified period of time using said calculated liquidation and expected expense values (Page 3, Paragraphs 7-9).

(S) As per claim 19, John discloses the method further comprising discounting said quantified values to provide net liquidation values for each specified time period (Page 3, Paragraphs 7-9).

(T) As per claim 20, Leslie discloses the method wherein the calculating said base score comprises: automatically calculating an expected probability a legally liable party will make a payment (Page 4, Paragraphs 3-6); automatically calculating an expected probable percentage of losses recovered through payments received from legally liable parties (Page 4, Paragraphs 3-6); and, automatically adjusting resultant scores for differences due to economic conditions or operation strategies or efficiencies (Page 2, Paragraphs 3-7).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(U) Claim 21 differs from claim 1 by reciting a computerized system for identifying select ones of insurance records which possess a favorable subrogation potential.

As per this limitation, it is noted that John discloses the system comprising: at least one computing device for receiving data indicative of a plurality of claims (Page 1, Paragraphs 1-3); and, a computer readable medium being accessible to said computing device, said computer readable medium comprising: a sequence of directions for automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data using said at least one computing device (Page 1, Paragraphs 1-3) and Leslie discloses a sequence of directions for automatically identifying risk factors for each of the select claims using said at least one computing device (See Leslie, Page 2, Paragraphs 4-7); and, a sequence of directions for automatically scoring each of the select claims dependently upon the base scores and identified risk factors to

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provide a value indicative of an expected subrogation recovery using said at least one computing device (See Leslie , Page 3, Paragraphs 1-9 to Page 4, Paragraph 1); and a means for outputting the value (The Examiner interprets "easily outstrip those in the other lines of business" to be a form of outputting the resulting value (See Leslie, Page 3, Paragraphs 2-9).

Thus, it is readily apparent that these prior art systems utilize a computerized system to perform their specified function.

The remainder of claim 21 is rejected for the same reasons given above for claim 1, and incorporated herein.

(V) As per claim 22, John discloses a computerized method for identifying select ones of insurance records which possess a favorable subrogation potential (Page 3, Paragraphs 9-12), the method comprising the steps of: receiving from a computer data base data indicative of a plurality of claims (Page 3, Paragraphs 7-14).

John does not explicitly disclose automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data; automatically identifying risk factors for each of the select claims; and, automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery and outputting the resulting value.

However, these features are known in the art, as evidenced by Leslie. In particular, Leslie suggests automatically calculating a base score to identify select ones

of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); automatically identifying risk factors for each of the select claims (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); and, automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Leslie within the system of John with the motivation of providing insurance fraud-fighters another set of tools to help them track down criminals. Powerful new software systems promise to dramatically improve their results (See Leslie, Page 1, Paragraph 5).

(W) As per claim 23, Leslie discloses the method further comprising the step of: automatically providing recovery strategy recommendation and recovery specialist checklists to optimize steps taken to recovery losses at minimum expense (Page 3, Paragraph 2).

The motivation for combining the respective teachings of John and Leslie are as discussed above in the rejection of claim 1, and incorporated herein.

(X) As per claim 24, John discloses a computerized method for identifying select ones of insurance records which possess a favorable subrogation potential (Page 3,

Paragraphs 9-12), the method comprising the steps of: receiving from a computer data base data indicative of a plurality of claims (Page 3, Paragraphs 7-14).

John does not explicitly disclose automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data; automatically identifying risk factors for each of the select claims; and, automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery; providing a user interface; and extracting the data from the user interface.

However, these features are known in the art, as evidenced by Leslie. In particular, Leslie suggests automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); automatically identifying risk factors for each of the select claims (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); and, automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); providing a user interface (See Leslie, Page 3, Paragraphs 1-5); and extracting the data from the user (See Leslie, Page 2, Paragraphs 4-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Leslie within the system of John with the

motivation of providing insurance fraud-fighters another set of tools to help them track down criminals. Powerful new software systems promise to dramatically improve their results (See Leslie, Page 1, Paragraph 5).

(Y) Claim 25 differs from claim 1 by reciting a computerized system for identifying select ones of insurance records which possess a favorable subrogation potential.

As per this limitation, it is noted that John discloses the system comprising: at least one computing device for receiving data indicative of a plurality of claims (Page 1, Paragraphs 1-3); and, a computer readable medium being accessible to said computing device, said computer readable medium comprising: a computer for executing a sequence of directions for automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data using said at least one computing device (Page 1, Paragraphs 1-3) and Leslie discloses a sequence of directions for automatically identifying risk factors for each of the select claims using said at least one computing device (See Leslie, Page 2, Paragraphs 4-7); and, a sequence of directions for automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery using said at least one computing device (See Leslie, Page 3, Paragraphs 1-9 to Page 4, Paragraph 1).

Thus, it is readily apparent that these prior art systems utilize a computerized system to perform their specified function.

The remainder of claim 21 is rejected for the same reasons given above for claim 1, and incorporated herein.

(Z) As per claim 26, John discloses a computerized method for identifying select ones of insurance records which possess a favorable subrogation potential (Page 3, Paragraphs 9-12) the method comprising the steps of: receiving from a computer data base data indicative of a plurality of claims (Page 3, Paragraphs 7-14); automatically identifying for each of the select claims at least one risk factor associated with the claim of affecting recovery chosen from the group comprising one of: limitations of legal process, state recovery limitations, failed attempts to recover on the claim, difficulties locating a legally liable party; underlying insurance, underlying insurance claim, insured liable party, uninsured liable party, one or more liable business, one or more liable individuals (The Examiner understands other types of claims to be a form of "failed attempts to recover on the claim See John, Page 3, Paragraphs 9-11).

John does not explicitly disclose automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependent upon the received data; for each of the select claims; and, automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery and outputting the value resulting therefrom.

However, these features are known in the art, as evidenced by Leslie. In particular, Leslie suggests automatically calculating a base score to identify select ones

of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); automatically identifying risk factors for each of the select claims (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); and, automatically scoring each of the select claims dependent upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery (See Leslie, Page 3, Paragraphs 4-9 to Page 4, Paragraph 1); and outputting the value resulting therefrom (The Examiner interprets "easily outstrip those in the other lines of business" to be a form of outputting the value resulting therefrom (See Leslie, Page 3, Paragraphs 2-9)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Leslie within the system of John with the motivation of providing insurance fraud-fighters another set of tools to help them track down criminals. Powerful new software systems promise to dramatically improve their results (See Leslie, Page 1, Paragraph 5).

Response to Arguments

5. Applicant's arguments filed on 04/14/05 with respect to claims 1-26 have been fully considered but they are not persuasive.

On pages 11-13, Applicant argues the prior art of record fail to disclose the following limitations "selecting claims on the basis of the base score which demonstrate at least a given probability of expected subrogation recovery dependent upon the

received data; and automatically identifying risk factors associated with the claim for each of the select claims.” The Examiner respectfully disagrees.

Leslie does not explicitly disclose “selecting claims on the basis of the base score which demonstrate at least a given probability of expected subrogation recovery dependent upon the received data” and “automatically identifying risk factors associated with the claim for each of the select claims”. However, Leslie does disclose using base scores to indicate the probability that certain claims are fraudulent (i.e. 500 score and 800 score)(page 3, paragraph 4). Leslie also teaches that certain risk factors are identified for those claims that are identified as being potentially fraudulent (i.e. indicates why the system flagged the claim)(page 3, paragraph 4). Although Leslie does not disclose these features with respect to subrogation recovery, Leslie does disclose that the same technology used for the fraud detection systems as disclosed in paragraphs 1-7 will be used in the development of other fraud detection system including the subrogation recovery system (page 3, paragraph 9). It seems that the software systems described in page 3 of Leslie use base scores to demonstrate the probability of an event and automatically identify risk factors associated with selected claims. Therefore, these limitations are disclosed by Leslie and Applicant’s arguments with respect to these features are deemed non- persuasive.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches legal strategic analysis

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planning and evaluation control system and method (5,875,431), integrated marketing and operations decisions-making under multi-brand competition (6,009,407) and computerized system and method for work management (5,557,515).

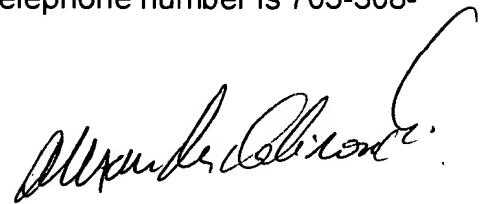
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F
V.F

June 2, 2005



ALEXANDER KALINOWSKI
PRIMARY EXAMINER